UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,995	08/22/2003	Graeme Horwood	9808-155/CPA	8679

27572 7590 01/24/2006

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
BLAU, STEPHEN LUTHER	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/645,995	HORWOOD ET AL.	
	Examiner	Art Unit	
	Stephen L. Blau	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9 and 10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *5-7,9 and 10* is/are allowed.

6)☒ Claim(s) *1 and 2* is/are rejected.

7)☒ Claim(s) *3 and 4* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. The examiner has identified how on the application data sheet it contains continuity information of the prior application 10/228,633 and it is agreed it does not also need to be in the first sentence of the specification.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3 and 5-6 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,729,970. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the two of the subsets claimed in this application are contained in the three subsets claimed in patent 6,729,970.

4. Claims 4 and 7-10 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,729,970 in view of 11-192328.

Claims 1-7 of U.S. Patent No. 6,729,970 lacks one subset of shaft including a 3,4 and 5 iron, and a second subset including a 6, 7,8,9 and wedge. 11-192328 discloses only two subsets of shafts (Page 4). 11-192328 does not disclose the two subsets being divided between the 5 iron and 6 iron but clearly an artisan skilled in the art of utilizing different materials for shafts in a subset would have selected a suitable division in a set in which between a 5 iron and a 6 iron is included. In view of the publication of 11-192328 it would have been obvious to modify the set of clubs of claims 1-7 of U.S. Patent No. 6,729,970 to have one subset of shaft including a 3,4 and 5 iron, and a second subset including a 6, 7,8,9 and wedge in order to simplify the manufacturing of a set by only have two different types of material and in order to have a more stiffer set of clubs for the 6-9 irons.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murtland in view of Iwanaga.

Murtland discloses a first shaft subset consisting of composite/metal combination shafts (Col. 4, Lns. 38-67) adapted to be connected to irons heads having a first predetermined range of shaft lengths (Col. 8, Lns. 45-55) in order to have clubs with part of a shaft providing rigid material offering mechanical consistency and part of the shaft with material which absorbs undesirable vibrations (Col. 3, Lns. 4-9).

Murtland lacks a set of shafts with the first shaft subset and a second shaft subset consisting of metal shafts adapted to be connected to irons heads having a second predetermined range of shaft lengths different from the first predetermined range.

Iwanaga discloses a second shaft subset in the form of wood type shafts (Table 2, Invention) consisting of metal shafts (Col. 3, Lns. 8-15) adapted to be connected to irons heads (Table 2, Dt 8.50 mm) having a second predetermined range of shaft lengths different from the first predetermined range (Table 1).

In view of the patent of Iwanga it would have been obvious to modify the subset of shafts of Murtland to include a second shaft subset consisting of metal shafts adapted to be connected to irons heads having a second predetermined range of shaft

lengths different from the first predetermined range in order to have a complete set of clubs of both irons and woods in playing a round of golf.

Allowable Subject Matter

1/20/06

5-7 and 9-10

7. Claims ~~5-10~~ are allowed. With respect to claims 5-6, none of the prior art discloses or renders as obvious a set of irons comprising a plurality of iron heads having varying lofts, a plurality of shafts individually coupled to said plurality of iron heads, a first shaft subset consisting of composite/metal combination shafts, and a second shaft subset consisting of one of composite shafts and metal shafts in addition to other elements of structure claimed. With respect to claims 7-10, none of the prior art discloses or renders as obvious a set of irons having all shafts in the first subset consist of one of composite shafts, composite/metal combination shafts and metal shafts and all shafts in the second subset consist of another one of composite shafts, composite/metal combination shafts and metal shafts such that the shafts in the first subset are different from the shafts in the second subset, a first subset including 3-5 irons, and a second subset including 6-9 and wedge irons in addition to the other elements of structure claimed.

8. Claims 3-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art discloses or renders as

obvious one of the subsets including 1-5 irons and another of the subsets including 6-9 irons and a wedge in addition to the other elements of structure claimed.

Response to Arguments

9. Applicant's arguments with respect to claims 1-2 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/20 January 2006

STEPHEN BLAU
PRIMARY EXAMINER